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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/104,123 06/24/98 RIOJA R 97-2301

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IM22/0920

EXAMINER

IP, S

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

09/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/7/00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8, 12, 16-22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8, 12, 16-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- A. Determining the scope and contents of the prior art.
- B. Ascertaining the differences between the prior art and the claims at issue.
- C. Resolving the level of ordinary skill in the pertinent art.
- D. Considering objective evidence present in the application indicating obviousness or unobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-8, 12, and 16-22 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5122339 to Pickens et al. (PTO-1449, Claim 1), USP 5211910 to Pickens et al. (PTO-1449, abstract), USP 5259897 to Pickens et al. (PTO-1449, abstract), JP 01025954 (abstract), WO 9532074 (abstract), WO 9212269 (abstract), or DE 2810932 (abstract).

5. Claims 1-8, 12, and 16-22 are rejected under 35 U.S.C. § 103 as being unpatentable over

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USP 5462712 to Langan et al. (PTO-1449, abstract), USP 5137686 to Rioja et al. (PTO-1449, abstract), USP 4869870 to Rioja et al. (PTO-1449, abstract), USP 4832910 to Rioja et al. (PTO-1449, claim 5), USP 4648913 to Sawtell et al. (abstract), USP 4806174 to Cho (abstract), USP 4790884 to Young et al. (abstract), or USP 5076859 to Rioja (abstract).

6. The cited references disclose the features substantially as claimed. The disclosed features include the claimed Al base alloy. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness, see See MPEP § 2112.01, *In re Best*, 195 USPQ 430, *In re Malagari*, 182 USPQ 549, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1-8, and 12-22 are rejected under the judicially created doctrine of double patenting over USP 5462712 to Langan et al. (PTO-1449, abstract), USP 5137686 to Rioja et al. (PTO-1449, abstract), USP 4869870 to Rioja et al. (PTO-1449, abstract), USP 4832910 to Rioja et al. (PTO-1449, claim 5), USP 4648916 to Sawtell et al. (abstract), USP 4806174 to Cho (abstract), USP 4790884 to Young et al. (abstract), or USP 5076859 to Rioja (abstract) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the instant Al base alloy composition is overlapped by the Al base alloys of cited patents.

10. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

11. Applicant's arguments filed July 7, 2000 have been fully considered but they are not persuasive.

12. Applicants' table in page 3 of the remarks summarized the alloy compositions of cited references are not accurate because claim 5 of USP 4832910 to Rioja et al discloses 0.5 - 5 wt.% Li, 0 - 5 wt.% Cu, 0 - 5 wt.% Mg, 0 - 7 wt.% Zn, 0 - 1 wt.% Zr, and 0 - 2 wt.% Mn.

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13. Applicants argue the cited references fail to control the Mg, Cu, and Li contents within maximum solubility in the Al base alloy. However, applicants have not pointed out which elements of cited references are exceeded the maximum solubility in the Al base alloy. Moreover, the instant properties listed in Table of page 13 of the instant specification are not better than properties in Table V of USP 5259897 to Pickens et al.

14. Applicants' argument in first full paragraph in page 4 of the instant remarks is noted. However, pages 5, 7, 11, and 12 and Figures 3-7 do not show claimed Li range is critical or any unexpected results. The alloy B has 0.19 wt.% Li. But its data has not been shown. Moreover, Figure 1B shows that the tensile yield strength of alloy A (0 wt.% Li), alloy B (0.19 wt.% Li), and alloy C (0.35 wt.% Li) has insignificant difference. Moreover, the Al base alloy properties are also affected by the heat treatment. Although the alloys may have the same composition, the properties are not necessary improved by Li if alloys are heat treated by T8 (see Figure 7). Comparison must be under identical condition except for the novel features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). Evidence offered by way of affidavit that is considerably narrower in scope than claimed subject matter (the instant claims have "comprising" transitional expression) is not sufficient to rebut prima facie case. In re Dill and Scales, 202 USPQ 805, 805.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

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policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached Monday to Friday from 6:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy King, can be reached on (703)-308-1146.

The facsimile phone number for "After Final Official Papers" is (703) 305-3599, "All Other Official Papers" is (703) 305-7718, and "Unofficial Papers" is (703) 305-7719. When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
September 18, 2000